DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/10 has been entered.

Election/Restrictions

2. Claims 1-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-11, 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4231829 to Marui et al in view of US 3316190 to Suzumura et al.

Claim 8, 21-22:

Marui teaches a process of transferring a pattern printed on a thin film of polyvinyl alcohol resin to a surface of an object by pressing the object to the thin film floated on the surface of the water (abstract). The film comprises 100 parts PVA polymer and .2 parts non-ionic surface active agent (claimed "surfactant") (col. 9, lines 41-49).

Additionally, Marui teaches that the extension rate of the film is at most about 60% (col. 5, lines 62-67). Marui is unclear as to the exact non-ionic surface active agent used. However, Suzumura teaches a cold water-soluble PVA film that is non-sticky at high humidity (col. 1, lines 10-14) and that surface active agents improve the cold water-solubility and reduces stickiness (col. 1, lines 51-67) wherein typical nonionic surface active agents include nonionic surfactants such as ethylene oxide adducts of lauryl alcohol (col. 2, lines 20-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use ethylene oxide adducts of lauryl alcohol as the non-ionic surface agent of Marui because Suzumura states that it is a suitable surface active agent for achieving the goal of improved cold water solubility and reduced stickiness. Additionally, the extension ratio under any conditions and the surface tension of the surfactant under any conditions are found to be properties of the claimed composition. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Additionally, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim 9:

The thin film additionally contains 10 parts of glycerin (Marui, col. 9, line 46) which is a plasticizer as defined by Applicant's specification (pg. 23).

Claim 10:

The thin film can additionally contain up to 50% starch (Marui, col. 3, lines 38-50) but preferably 10 parts (Marui, col. 8, lines 14-15).

Claim 11:

The thin film contains .5 parts boric acid (Marui, col. 9, line 47).

Claim 14:

The film thickness is .035 mm which converts to 35 micrometers (Marui, col. 9, lines 51-52).

Claims 19-20:

A pattern is printed onto the thin film and may be carried out by any known printing process (Marui, col. 5, lines 17-18).

Claims 13, 15-18:

These limitations are determined to be properties of the claimed composition. Where the claimed and prior art products are identical or substantially identical in structure or

composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Additionally, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 4231829 to Marui et al and US 3316190 to Suzumura et al in view of US 3220992 to Smyser et al.

Marui and Suzumura are discussed above but fail to teach the moisture content of the dried film. However, Smyser teaches a PVA film and a method for preparing a PVA film (col. 1, lines 10-15) wherein the slurrying and solubility characteristics of the PVA may be improved (col. 1, lines 57-60) by controlling the moisture content between 2% and 4% (col. 2, lines 28-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to produce the film of Marui and Suzumura with the moisture content of Smyser because Smyser states that doing so improves the slurrying and solubility characteristics of the PVA.

Response to Amendment

8. The declaration under 37 CFR 1.132 filed 12/22/10 is insufficient to overcome the rejection of claims 8-11, 13-22 based upon 103(a) over Marui et al in view of Suzumura et al as set forth in the last Office action because: the declaration is directed to the knowledge and understanding of Marui and Suzumura to a person skilled in the art and their relation to the extension ratio; and this declaration is not convincing because the extension ratio is determined to be an inherent property of the composition of the film; therefore, whether or not a person skilled in the art would understand the relationship between the extension ratio and the nonionic surfactant is not relevant.

Response to Arguments

9. Applicant's arguments filed 12/22/10 have been fully considered but they are not persuasive.

10. Applicants assert, in the last paragraph of page 2, that Examples 3-5 of the specification demonstrate unexpected results. This is not convincing because no evidence has been provided to substantiate such a claim, particularly evidence compared to the closest prior art.

11. In response to applicant's arguments, in the last paragraph of page 3, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, that Marui does not teach a specific

nonionic surfactant and Suzumura does not teach printing. Additionally, the surface tension is found to be an inherent property of the surfactant as discussed above.

12. Applicant argues, in the last paragraph of page 4, that the Examiner has not provided proof of inherency. However, as stated above, the proof of inherence is based on the principle that identical material will have identical properties. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In this case, as the composition claimed and the composition taught by the combination of Marui and Suzumura and identical, it is expected that the properties of such composition are identical.

Conclusion

13. No Claims are allowed. All pending claims are rejected for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX ROLLAND whose telephone number is (571)270-5355. The examiner can normally be reached on Monday though Friday, 9:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571)272-1418. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALEX ROLLAND/
Examiner, Art Unit 1712

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1712